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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/577,698	04/28/2006	Bhunia Debnath	DRF33029	3725
22827 DORITY & MA	7590 03/04/200 ANNING, P.A.	EXAMINER		
POST OFFICE	BOX 1449	MCDOWELL, BRIAN E		
GREENVILLE, SC 29602-1449			ART UNIT	PAPER NUMBER
			1624	
			MAIL DATE	DELIVERY MODE
			03/04/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	cation No. Applicant(s)						
Office Action Occurrence	10/577,698	DEBNATH ET AL.						
Office Action Summary	Examiner	Art Unit						
	BRIAN MCDOWELL	1624						
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address						
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period w - Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be time will apply and will expire SIX (6) MONTHS from cause the application to become ABANDONEI	lely filed the mailing date of this communication. (35 U.S.C. § 133).						
Status								
1)⊠ Responsive to communication(s) filed on <u>05 Fe</u>	ebruary 2009							
	action is non-final.							
3) Since this application is in condition for allowan		secution as to the merits is						
closed in accordance with the practice under <i>E</i>								
Disposition of Claims								
4)⊠ Claim(s) <u>28-72,75 and 76</u> is/are pending in the	application.							
4a) Of the above claim(s) <u>32-34,36-62,65-69,71</u>	• •	consideration.						
5) Claim(s) is/are allowed.								
6) Claim(s) <u>28-31,35,63,64 and 70</u> is/are rejected	<u></u>							
7) Claim(s) is/are objected to.								
8) Claim(s) are subject to restriction and/or	election requirement.							
Application Papers	·							
9)☑ The specification is objected to by the Examiner 10)☐ The drawing(s) filed on is/are: a)☐ acce		Evaminor						
Applicant may not request that any objection to the o								
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d). 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.								
TT) The datifor declaration is objected to by the Ex-	animer. Note the attached Office	Action of form F 10-192.						
Priority under 35 U.S.C. § 119								
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 								
Attachment(s) 1) X Notice of References Cited (PTO-892)	4) ☐ Interview Summary	(PTO-413)						
2) DNotice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Da	ite						
3) Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	5) Notice of Informal P	atent Application						
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DETAILED ACTION

RESPONSE TO ELECTION/RESTRICTION

Applicant's election of group I and election of specie (example 13, page 9 of specification) in the reply filed on 2/5/2009 is acknowledged. The elected specie reads on claims 28-31, 35, 63, 64, and 70. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

Claims 32-34, 36-62, 65-69, 71, 72, 75, and 76 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim.

This application contains claims drawn to an invention nonelected without traverse in the reply filed on 2/5/2009. A complete reply to this action must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Applicant's elected specie was found free of the prior art and the full scope of the claims were examined.

An action on the merits of claims 28-31, 35, 63, 64, and 70 is contained herein.

Priority

This application receives the foreign priority date of 10/28/2003, drawn to foreign application 862/CHE/2003.

Specification

The abstract of the disclosure is objected to because of the following. Applicant is reminded that the abstract of the disclosure should not exceed more than 150 words.

Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 64 is objected to because of the following informalities: The claim should be more appropriately stated as the following: "A pharmaceutical composition comprising the compound of claim 30 and a pharmaceutically acceptable carrier, diluent, or excipient". Appropriate correction is required.

Claim Rejections - 35 USC § 112 (2nd Paragraph)

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 28-31, 35, 63, 64, and 70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the absence of the specific derivatizations to the (compound claimed) core or distinct language to describe the structural modifications or the chemical names of derivatized (compounds claimed) of this invention, the identity of said derivatives would

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be difficult to describe and the metes and bounds of said derivatives applicants regard as the invention cannot be sufficiently determined because they have not been particularly pointed out or distinctly articulated in the claims.

Claims 28-31, 35, 63, 64, and 70 are also rejected for the limitation "and their pharmaceutically acceptable compositions". The examiner is uncertain to what pharmaceutically acceptable compositions are supposed to be embraced by the claims, thus the metes and bounds are not clear. It is recommended that the aforementioned limitations be removed from the claims to overcome this rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 28, 29, 63, and 70 are rejected under 35 U.S.C. 102(e) as being anticipated over Fujimoto et al. (US Patent 7,202,364).

Fujimoto et al. disclose the following compounds (see col. 48):

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Com-			
pound	R.	A	mp., MS
(b)	Ci	6-Ci-5-indanyi	132–134° C.
(e)	Ci .	3-quinolinyi	193-195° C.
$\langle \mathbf{q} \rangle$	H	1-Ci-2-naphthyl	156-158° C.
(e)	CH_3	1-Ci-2-rephthyl	141–143° €.
(S)	Ci	2-naphthyl	128-130° C.
(g)	C:	i-Ci-2-nephthyl	156-158° C.
(3)	Ħ	2-P-4-cycicpropyiphenyl	104–105° C.
(i)	CH ₃	3-methyl-6-quinolinyl	172–175° €.
(1)	H	4-(4-F-phenyi)-2-F-phenyi	M=1=338,
			36 + 1 = 349
(k)	H	6-Ci-5-indanyi	133–134° C.
(1)	H	4-phenyi-2-F-phenyi	M - 1 = 320
			M + 1 = 322
(m)	H	3-quinollayi	182–184° C.
(z)	\mathbb{H}	2-naphthyl	131–133° C.
$\langle \mathfrak{L} \rangle$	CH ₃	2-nephthyl	130–132° C.
(5)	Ci	2-Ci-4-cyclopropylphenyl	128–129° C.
$\langle d \rangle$	CH_2	2-Cl-4-cyclopropylphenyl	114-116° €.
(1) (1) (2) (3) (4) (4) (4) (4) (4) (4) (4) (4) (4) (4	C:	4-phenyi-2,3,5,5-tetra-3-phenyi	181–182° €.
(3)	CH_2	4-phanyi-2,3,5,5-tatra-7-phanyi	156–157° C.
(\$)	CH ₃	I-Ci-4-cyclopropyl-6-F-phenyl	M = 1 = 332
			334
$\langle u \rangle$	Ci	4-(4-F-phenyi)-2-F-phenyi	36 - 1 = 372,
			M+1=374
$\langle \mathbf{v} \rangle$	H	4-(4-OCH ₃ -phesyi)-2-Cl-phenyi	150–151° C.
$\langle w \rangle$	Ci	4-(4-OCH ₃ -phenyi)-2-F-phenyi	100–102° €.
$\langle \mathbf{M} \rangle$	H	4-phenyi-2,6-di-Ci-phenyi	191–192° C.
$\langle \mathbf{y} \rangle$	H	4-phenyi-2-Ci,6-F-phenyi	162–163° C.
(z)	CHa	4-phenyi-2-Ci,6-F-phenyi	175–177° C.
(<u>3</u> 8)	CH_3	4-phenyl-2,6-di-Cl-phenyl	177–178° C.
$\langle zz \rangle$	CH ₂	4-(3-CH ₂ O-phenyi)-2,3,5,6-tstra-F-phenyi	164–166° C.
$\langle ec \rangle$	Cì	4-(3-CH ₃ O-phenyi)-2,3,5,6-terre-F-phenyi	171–173° €.
(a d)	CH3	4-(4-F-phenyi)-2,3,5,6-tetra-F-phenyi	155–158° C.
(ze)	Ci	4-(3,4-methylesedioxyphesyl)-2-3,5,6-tetra-F-phenyl	M-1=452
$(\underline{x}\underline{x})$	CH₃	4-cyclahexyl-2-Cl-phenyl	133–135° C.

See compounds (d) and (n) in particular, wherein Ar_1 = 2-naphthyl or 1-Cl-2-naphthyl, p = m = 0, and R^{5-7} = H that read on the aforementioned claims and are therefore anticipated.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 63-64 and claim 70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The term "solvate" is not found in the disclosure as originally filed, thus the examiner asserts that applicant was not in possession of said "solvate" of the claimed compounds at the time the application was originally filed.

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BRIAN MCDOWELL whose telephone number is (571)270-5755. The examiner can normally be reached on Monday-Thursday 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BM

/James O. Wilson/

Supervisory Patent Examiner, Art Unit 1624